

PATENT
IBM Docket No. JP920000182US1

REMARKS

The claims have been amended by rewriting claims 4, 8, 12, 14 and 15. Claims 1-15 remain in the application.

Applicants respectfully request that the rejection of the claims presented be reconsidered and withdrawn in light of the amendments above and the discussion which follows and that the application be found in condition for immediate allowance.

Claim Objections

The Examiner has objected to claim 14 on an Informal basis because the word "under" should be "over". In response, Applicants have amended the claim to conform with the Examiner's requirement.

Claim Rejections

The 35 USC §102 Rejections

It is Applicants' understanding that a rejection on the basis of anticipation under 35 USC 102 is appropriate where each element of a claim at issue is found in a single prior art reference. See Kalman v Kimberly-Clark Corp., 218 USPQ 781 at 789, (Fed. Cir. 1983). The requirement is for an element by element comparison of the recited structure, function and operative steps with what is found in the reference sought to be applied. The rejection is proper where such an element by element comparison finds identity for each element within the four corners of the reference.

It is respectfully submitted that the rejection made in the Official Action falls short of this standard. Further, it is respectfully submitted that no rejection can be framed on the basis of the references cited, whether applied or not, which will support a refusal to

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allow the claims as presented, without regard for whether that possible rejection is grounded on anticipation under 35 USC 102 or obviousness under 35 USC 103.

Claim 1

Claim 1 stands rejected (as do all claims presented) as anticipated by the disclosure of Sato, JP 2000112579 (Hereinafter "Sato"). Applicants respectfully that this rejection is not proper.

Here, the rejection fails to find identity with at least the following bold-highlighted portions of claim 1:

1. An electronic power supply apparatus, comprising:
a source power supply which supplies to a system electric power received from an external power source;
a battery which is charged with electric power supplied from said source power supply and which discharges electric power to said system; and
an electric power supply controller coupled to said source power supply and to said battery and which controls supply of electric power to said system from said source power supply and said battery;
said electric power supply controller switching supply of electric power between said source power supply and said battery to said system **based upon:**
 - a) connection status of said source power supply, and
 - b) connection status of said battery, and**
 - c) a system parameter indicative of the status of said system.

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Thus, the switching of electrical power between the power supply and the battery must be based on all three conditions (a), (b), and (c), which includes the connection status of the battery and not just the source power supply.

Paragraphs [0001] and [0005] of Sato make it clear that the battery in Sato is a built-in battery. Thus, the connection of the built-in battery is always assumed to exist. There is no determination needed nor disclosed. Battery disconnection and connection is not contemplated by Sato. The steps of Sato's figure 2 would lead to system lock-up if the battery could be removed from Sato's device because battery power is assumed and as soon as the AC/DC converter 21 of Sato is turned off the entire device would lose its ability to turn back on. AC/DC converter 21 would be OFF and no command from line 35 is possible with a disconnected battery.

In contrast, Applicants contemplated this predicament. As can be seen from Applicants disclosure, a lock up of this sort is not possible with Applicants' device. For example, see Figure 4 at step S103. There, if the battery is not connected, further power-saving processes are discontinued.

With respect to the cited paragraph in Sato, the Examiner has made the assertion that Sato's paragraph [0032] finds identity with the above bold highlighted limitation. Applicants respectfully disagree. Paragraph [0032] of Sato makes no mention of a battery much less the switching of electrical power between the power supply and the battery based on the connection status of the battery. Sato paragraph [0032] teaches detection of whether the power source (AC adapter 20 of Sato) is connected and not the battery. Therefore, Applicants respectfully assert that the Examiner's reading of Sato's paragraph [0032] as the above highlighted limitation is hereby respectfully traversed.

Should the Examiner disagree, it is respectfully requested that the Examiner provide specific pointers to the location in the references of a teaching of switching electrical power between a source power supply and a battery based on the **connection status of the battery**.

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For the reasons given above, it is the position of Applicants that Claim 1 defines an invention which is patentably distinct from the reference cited under the tests of both 35 USC 102 and 35 USC 103 (since limitations are missing). Should the Examiner conclude otherwise, it is respectfully requested that the Examiner's arguments be clarified in any next following Official Action in order that Applicants may more clearly understand the element by element identification (if the rejection is under 35 USC 102) and/or the teaching which suggests obviousness of any combination of references (if the rejection is under 35 USC 103).

Claims 2 and 3

With respect to claims 2 and 3, these claims are believed to be in condition for immediate allowance due to their dependence on independent claim 1 which is believed to be allowable.

Claim 4

Turning now to claim 4, claim 4 has been amended to include the limitation argued above with respect to claim 1 and, as amended, is believed to be patentable for the at least the reasons given with respect to claim 1.

Claims 5-7

With respect to claims 5-7, these claims are believed to be in condition for immediate allowance due to their dependence on independent claim 4 which is believed to be allowable.

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Claim 8

Turning now to independent claim 8, this claim has been amended to include the limitation argued above with respect to claim 1 and is believed to be patentable for the at least the reasons given with respect to claim 1.

Claims 9-11

With respect to claims 9-11, these claims are believed to be in condition for immediate allowance due to their dependence on independent claim 8 which is believed to be allowable.

Claim 12

Turning now to independent claim 12, this claim has been amended to include the limitation argued above with respect to claim 1 and is believed to be patentable for the at least the reasons given with respect to claim 1.

Claim 13

With respect to claim 13, this claim is believed to be in condition for immediate allowance due to its dependence on independent claim 12 which is believed to be allowable.

Claim 14

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Turning now to independent claim 14, this claim has been further amended to include the limitation argued above with respect to claim 1 and is believed to be patentable for the at least the reasons given with respect to claim 1.

Claim 15

With respect to claim 15, this claim is believed to be in condition for immediate allowance due to its dependence on independent claim 12 which is believed to be allowable.

Support for the above amendments can be found at least in Applicants Figure 4 and at least specification page 16, lines 17-23.

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Request to Proceed to Allowance

For each and all of the reasons set forth above, and as Applicants believe each and all of Examiner's rejections and or objections have been traversed or rendered moot, Applicants respectfully request that this response be considered, entered, and a timely notice of allowance be issued.

The Examiner is urged to call the undersigned at the below-listed telephone number if, in the Examiner's opinion, such a phone conference would expedite or aid in the prosecution of this application.

Respectfully Submitted,



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